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OFFICE OF PETITIONS

In re Application of :
Lin et al. :
Application No. 09/721,851 : DECISION ON APPLICATION
Filed: November 24, 2000 : FOR
Attorney Docket No. SJO919980026US2 : PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed September 29, 2003, requesting that the Office reconsider the determination of Patent Term Adjustment (PTA) that accompanied the Notice of Allowance. Applicants request that the initial determination of patent term adjustment be corrected from one hundred fifty-seven (157) days to three hundred ninety-seven (397) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred sixty-one (261) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

BACKGROUND

On August 25, 2003, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants was advised that the patent term adjustment to date was 157 days. The period of adjustment of 261 days was reduced by 104 days for applicant delay.

In response, applicants timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 CFR 1.18(e)¹. Applicants request that the patent term adjustment be corrected to 397 days. The basis for this correction is 37 CFR 1.702(a)(1). Applicants contend that the patent term should be adjusted because the application

¹ PALM records indicate that the Issue Fee was received in the Office on October 28, 2003.

was filed November 24, 2000 and the first notification received by the Applicant was in the form of an Office action mailed by the USPTO on February 25, 2003, fourteen months and 397 days after the application filing date. Applicants state that the Office may have mailed a notification prior to the first notification to a wrong address. In support thereof, applicants submitted a copy of a return postcard date-stamped May 29, 2001, and acknowledging receipt in the Office of a "Request for Change of Address" listed thereon. (Applicants do not address the entry of a period of adjustment of 25 days for Office delay in responding to their response filed March 31, 2003. It is noted that this period of adjustment is correct.)

Applicants further state that the patent issuing from the application is not subject to a terminal disclaimer and that there were no circumstances in the prosecution of the application which constituted failure to engage in reasonable efforts to conclude processing or examination.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to-

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after-

(i) the date on which an application was filed under section 111(a) of this title; or
(II) the date on which an international application fulfilled the requirements of section 371 of this title;

37 CFR § 1.702 provides that:

(a) Failure to take certain actions within specified time frames . Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

37 CFR § 1.704(b) provides that:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant ...

OPINION

Applicants' arguments and evidence have been considered, in light of the application history, and it has been determined that the initial period of adjustment pursuant to § 1.702(a)(1) is correct. Applicants may not have received the Office action. Nonetheless, the Office did mail a proper first notification under 132 on September 17, 2002.

The record supports a conclusion that a first notice was mailed to applicants at:

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It is recognized that, as provided in the change of address filed by attorney Johnston on May 29, 2001 (and cited in support of the instant application for patent term adjustment), the first notice should have been mailed to applicants at:

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IP Law L2PA/014
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Correspondence was mailed to the address specified in the change of address, although the name of the attorney was included in the address and "IBM IP Law L2PA/014" was omitted. Since the correct company name, street address, city and state were used, the correspondence was properly addressed. Accordingly, the period of adjustment was properly calculated as 236 days, counting the number of days beginning on January 25, 2002, the day after the date that is fourteen months after the date on which the application was filed, to September 17, 2002, the date of mailing of the restriction requirement.

Pursuant to 35 U.S.C. 154(b)(1)(A), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first 14 months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until September 17, 2002. The fact that the correspondence was subsequently remailed does not alter the fact that the Office did mail an action under 35 U.S.C. 132 to the applicants on September 17, 2002. Accordingly, in this case, it is correct for the Office to use the date of September 17, 2002 in calculating the period of adjustment due to the examination delay in initially acting on this application. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

Thus, it is concluded that, in this instance, the remailing of the action under 35 U.S.C. 132 did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

However, applicants are correct that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the patent application under 37 CFR 1.704. In view of the remailing of the restriction requirement and the restarting of the period for reply, the entry of a period of reduction of 104 days for applicant delay is not warranted. As the record establishes that applicants did not receive the restriction requirement originally mailed September 17, 2002, that date should not be used in calculating applicant delay pursuant to 37 CFR 1.704(b). Rather, the date of remailing of the restriction requirement should be used. As applicants' response to the restriction requirement remailed February 25, 2003, was received in the Office on March 31, 2003, it is concluded that applicants did not take in excess of three months to respond. There was no applicant delay within the meaning of § 1.704(b), and the reduction of 104 days is not warranted.

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is two hundred sixty-one (261) days.

CONCLUSION

In view thereof, the petition is **GRANTED** to the extent indicated herein.

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 09-0442, as authorized. This fee is required and will not be waived.

The application file is being forwarded to the Office of Patent Publications for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

Karin Ferriter
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Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy